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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,739

01/09/2004

James L. Skinner

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EXAMINER

NGUYEN, DANNY

ART UNIT

PAPER NUMBER

2836

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/754,739	<b>Applicant(s)</b> SKINNER, JAMES L.	
	<b>Examiner</b> Danny Nguyen	<b>Art Unit</b> 2836	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 and 26-35 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-12 and 19-23 is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-18, 24, 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 1/19/2007 with respect to claims 1, 10, 13, 19, 24 have been considered and persuasive. In view of these arguments, claims 1, 13 and 24 are moot in view of the new ground(s) of rejection, and claims 10 and 19 are allowed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 8, 9, 13-15, 24, 26-32, 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Shilo (USPN 5,321,575).

Regarding claims 1, 8, 9, Shilo discloses a protection circuit (figure 1) comprises a live line (10), a second line (12), a ground line (14), and a surge protector circuit (6) including a first varistor (18), and a gas discharge tube (22, col. 2, lines 63-65) that is non-conductive below trigger voltage and that is conductive above the trigger voltage, wherein the trigger voltage is greater than a hi pot test voltage (e.g. col. 2, lines 22-32, col. 3, lines 10-18), wherein the gas discharge tube and the varistor are coupled in series between the live line and the ground, the gas discharge tube being operably to clamp voltage in the surge protector by diverting excess voltage from the live line to the ground (col. 2, 3, lines 63-17).

Regarding claims 2, 26, Shilo discloses the first varistor (18) has a voltage threshold that is less than the hi pot voltage testing and the trigger voltage, wherein the hi pot test voltage is less than the trigger voltage, and the trigger voltage is less than a surge voltage (e.g. col. 2, lines 8-18, col. 3, lines 14-18, lines 47-53).

Regarding claims 3, 4, 14, 15, 27, 28, Shilo discloses a second varistor (20) coupled between the second line and the ground, and when a voltage on the live line exceeds the trigger voltage, the first varistor, the second varistor, and the GDT clamp excess voltage (col. 3, lines 54-60).

Regarding claims 24, 29-32, 35 Shilo discloses a method for insulation testing an electric machine with a surge protection circuit comprises providing an electric machine (such as electric device is coupled to the surge device 6, col. 1, lines 15-20) having a live line (10), a ground line (14) and a second line (12); connecting a first varistor (18) and a gas discharge tube (GDT) (such as 22) in series between the live line and said ground line, thereby operably connecting said GDT to clamp voltage by diverting excess voltage from one of said live line to said ground line, setting a trigger voltage of said GDT greater than a hi-pot test voltage, wherein said GDT is conductive above said trigger voltage and non-conductive below said trigger voltage; and performing said insulating testing (e.g. col. 2, lines 22-32, col. 3, lines 10-18, col. 2, 3, lines 63-17).

Regarding claim 13, Shilo discloses a protection circuit (figure 1) comprises a live line (10), a second line (12), a ground line (14), and a surge protector circuit (6) including a first varistor (18), and a gas discharge tube (22, col. 2, lines 63-65) that is non-conductive below trigger voltage and that is conductive above the trigger voltage,

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wherein the trigger voltage is greater than a hi pot test voltage (e.g. col. 2, lines 22-32, col. 3, lines 10-18), wherein the gas discharge tube and the varistor are coupled in series between the live line and the ground, the gas discharge tube being operably to clamp voltage in the surge protector by diverting excess voltage from the live line to the ground (col. 2, 3, lines 63-17), a second varistor (20) coupled between the second line and the ground.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shilo in view of Stanford et al (USPN 6,496,015). Shilo discloses all limitations of claim 24 as discussed above, but does not disclose a testing time as claimed. Stanford discloses a dielectric voltage withstand test comprises a test time is one second (col. 1, lines 25-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the test circuit of Sholi to incorporate the test time as disclosed by Stanford in order to quickly determine the breakdown occurred in the system.

4. Claims 5-7, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shilo in view of Newman, Jr. (USPN 5,555,150). Shilo discloses all limitations of claim 1 as discussed above, but do not disclose a fuse, and a rectifier as claimed.

Newman discloses a high potential testing circuit with a protection circuit (figure 1) comprises a fuse, and rectifier (20) that communicates with the live and second lines that converts an AC input to a DC output. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the circuit of Shilo to incorporate the fuse and the rectifier as disclosed by Newman in order to provide an overcurrent protection and rectify the AC input voltage.

***Allowable Subject Matter***

5. Claims 10-12, 19-23 are allowed.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Nguyen whose telephone number is (571)-272-2054. The examiner can normally be reached on Mon to Fri 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571)-272-2058. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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4/4/2007



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